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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,413	03/03/2000	George Francis DeStefano	ROC920000010	7577

7590 06/16/2005

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EXAMINER

VU, KIEU D

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/519,413

Applicant(s)

DESTEFANO ET AL.

Examiner

Kieu D. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/20/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAIL ACTION

1. This Office Action is in response to the Amendment filed 04/20/05 and the Affidavit Under CFR 1.131 filed 03/10/05.
2. The Affidavit filed on 03/10/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Fang (USP 6628311) reference.

Firstly, it is noted that the Affidavit Under CFR 1.131 filed 03/10/05 is improper since it is not made under oath before a notary public (see MPEP 715.04).

Secondly, although the Affidavit establishes a conception of the invention prior to the effective date of the Fang reference, the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Fang reference to either a constructive reduction to practice or an actual reduction to practice. Specifically, it is noted that the disclosure of the invention to IBM's Intellectual Law department shows a conception of the invention on December 1999. However, the Affidavit fails to show evidence of reduction to practice from December 1999 to the filing date the Fang reference which is Feb 2000 (see MPEP 715.07 (a)).

Claim Objections

3. Claim 14 is objected to because of the following informalities: it appears that line 2 of the claim has a typographical error. "claim 1" should be replaced with "claim 13".

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 13-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 13, lines 7-8 of the claim recites feature "including identifying a restricted selection". Lines 9-10 of the claim recites feature "including removing the restricted selection". However, these features are not found in the specification.

Claims 14-18 depend on claim 13; therefore, claims 14-18 are rejected on the same rationale.

Regarding claim 17, lines 3-4 of the claim recites feature "identifying a restricted selection and a privilege class for the restricted selection". However, these features are not found in the specification

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fang (USP 6628311).

Regarding claims 1 and 9, Fang teaches steps identify code for disabling control (identify that the Staple control is deactivated (col 1, lines 40-41), changing a state of

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identified code from disabled to disabled with assistance (the Staple display control is deactivated and provide help icon to provide help information on the deactivated Staple control; col 1, lines 42-47); responsive to said change of state of identified code to disabled with assistance, providing assistance text to explain why control is disabled (help information explains that the Staple control is deactivated since Booklet Printing is selected; Fig. 3a) and providing code for correcting a condition for disabling control (in order to activate the Staple control, Booklet Printing should not be selected), receive user selection to adjust a display control to execute said code for correcting a condition for disabling control (upon user selection to adjust from "Booklet Printing" to "Side Biding" in control Duplex/Booklet 16, the condition for deactivated Staple control is corrected, and the Staple control is activated) (see col 1, lines 34-63) (also see col 3, lines 37-65).

The only difference between Fang teaching and the claims is that in order to correct a condition for disabling control (change Staple control from deactivated to activated in Fang), the claims teach selecting an adjustment button while Fang teaches selecting on a list of items (for example, select "Side Biding" in the drop-down list of control Duplex/Booklet 16 (see col 1, lines 57-61), or select item "Finisher installed" on the dialog box 40 and select check box "Finisher" on "Option" list on Fig. 3b.

Since Fang teaches that it is well-known that plurality of buttons (such as push buttons, radio buttons; see col 1, lines 30-32; col 4, lines 45-47) may be used to develop a graphical user interface, an Official Notice is taken that it would have been obvious for one of ordinary skill in the art, having the teaching of Fang before him at the time the invention was made, to modify the graphical user interface taught by Fang to include a

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button for selecting "Side Biding" or "Finisher installed" with the motivation being to provide different ways to select items.

Regarding claim 8, Fang teaches steps identify code for disabling control (identify that the Staple control is deactivated (col 1, lines 40-41), changing a state of identified code from disabled to disabled with assistance (the Staple display control is deactivated and provide help icon to provide help information on the deactivated Staple control; col 1, lines 42-47); displaying an assistance icon for viewing by a user (help icon 26 of Fig. 2a; col 1, lines 43-46), identifying a user selection of said assistance icon and displaying said assistance text (col 1, lines 46-48; Fig. 2a-2b), responsive to said change of state of identified code to disabled with assistance, providing assistance text to explain why control is disabled (help information explains that the Staple control is deactivated since Booklet Printing is selected; Fig. 3a) and providing code for correcting a condition for disabling control (in order to activate the Staple control, Booklet Printing should not be selected), receive user selection to adjust a display control to execute said code for correcting a condition for disabling control (acting on eligible items) (upon user selection to adjust from "Booklet Printing" to "Side Biding" in control Duplex/Booklet 16, the condition for deactivated Staple control is corrected, and the Staple control is activated) (see col 1, lines 34-63) (also see col 3, lines 37-65).

The only difference between Fang teaching and claim 8 is that in order to correct a condition for disabling control (change Staple control from deactivated to activated in Fang), claim 8 teaches selecting an adjustment button while Fang teaches selecting on a list of items (for example, select "Side Biding" in the drop-down list of control

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Duplex/Booklet 16 (see col 1, lines 57-61), or select item "Finisher installed" on the dialog box 40 and select check box "Finisher" on "Option" list on Fig. 3b.

Since Fang teaches that it is well-known that plurality of buttons (such as push buttons, radio buttons; see col 1, lines 30-32; col 4, lines 45-47) may be used to develop a graphical user interface, an Official Notice is taken that it would have been obvious for one of ordinary skill in the art, having the teaching of Fang before him at the time the invention was made, to modify the graphical user interface taught by Fang to include a button for selecting "Side Biding" or "Finisher installed" with the motivation being to provide different ways to select item.

Regarding claims 2 and 10, Fang teaches the displaying an assistance icon for viewing by a user in responsive to said change state of said identified code to disabled with assistance state (help icon 26 of Fig. 2a; col 1, lines 43-46).

Regarding claims 3 and 11, Fang teaches the identifying a user selection of said assistance icon and displaying said assistance text (col 1, lines 46-48; Fig. 2a-2b).

Regarding claim 6, Fang teaches the including the step of displaying a help text for viewing by a user (Fig. 3a).

Regarding claim 7, Fang teaches the step of providing an assistance icon with said identified code, said assistance icon for viewing by a user in a context menu of available actions for user selected items (Fig. 3a).

Regarding claims 5 and 12, Fang teaches receive user selection to adjust a display control to execute said code for correcting a condition for disabling control (acting on eligible items) (upon user selection to adjust from "Booklet Printing" to "Side Biding" in control Duplex/Booklet 16, the condition for deactivated Staple control is

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corrected, and the Staple control is activated) (see col 1, lines 34-63) (also see col 3, lines 37-65). The only difference between Fang teaching and the claims is that in order to correct a condition for disabling control (change Staple control from deactivated to activated in Fang), the claims teach selecting an adjustment button while Fang teaches selecting on a list of items (for example, select "Side Biding" in the drop-down list of control Duplex/Booklet 16 (see col 1, lines 57-61), or select item "Finisher installed" on the dialog box 40 and select check box "Finisher" on "Option" list on Fig. 3b. Since Fang teaches that it is well-known that plurality of buttons (such as push buttons, radio buttons; see col 1, lines 30-32; col 4, lines 45-47) may be used to develop a graphical user interface, an Official Notice is taken that it would have been obvious for one of ordinary skill in the art, having the teaching of Fang before him at the time the invention was made, to modify the graphical user interface taught by Fang to include a button for selecting "Side Biding" or "Finisher installed" with the motivation being to provide different ways to select items.

8. Claims 1-3, 5-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston (USP 6,452,607).

Regarding claims 1 and 9, Livingston teaches steps identifying code for disabling control (identify that control option 100 is disabled) (see col. 4, lines 10-14), changing a state of identified code from disabled to disabled with assistance (disabled option 100 is detected as being noteworthy) (col. 4, lines 9-11); responsive to said change of state of identified code to disabled with assistance, providing assistance text to explain why control is disabled (help information explaining why control 100 is disabled) (col. 4, lines

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18-23) and providing code for correcting a condition for disabling control (providing guidance on what user should do to enable control 100) (col. 4, lines 18-23), receive user selection to adjust a display control to execute said code for correcting a condition for disabling control (upon user selection of A4 in the drop-down list of the control "Size is", (see Figures 2-4), control 100 will be enable) (see col. 4, lines 9-27) (also see col. 5, lines 11-17).

The only difference between Livingston teaching and the claims is that in order to correct a condition for disabling control (change control 100 from disable to enable in Livingston), the claims teach selecting an adjustment button while Livingston teaches selecting on a list of items (for example, select "A4" in the drop-down list of control "Size is" (see Figure 4). Since Livingston teaches that "GUI components, such as icons or buttons, may visually represent figures for enabling computer functions" (col 1, lines 27-32), an Official Notice is taken that it would have been obvious for one of ordinary skill in the art, having the teaching of Livingston before him at the time the invention was made, to modify the graphical user interface taught by Livingston to include a button for selecting "A4" with the motivation being to provide different ways to select items.

Regarding claim 8, Livingston teaches steps identifying code for disabling control (identify that control option 100 is disabled) (see col. 4, lines 10-14), changing a state of identified code from disabled to disabled with assistance (disabled option 100 is detected as being noteworthy) (col. 4, lines 9-11); displaying an assistance icon for viewing by a user (help icon 110) (col. 4, lines 13) (see Fig. 2), identifying a user selection of said assistance icon and displaying said assistance text (col. 4, lines 12-27), responsive to said change of state of identified code to disabled with assistance,

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providing assistance text to explain why control is disabled (help information explaining why control 100 is disabled) and providing code for correcting a condition for disabling control (providing guidance on what user should do to enable control 100) (col. 4, lines 18-23), receive user selection to adjust a display control to execute said code for correcting a condition for disabling control (acting on eligible items) (upon user selection of A4 in the drop-down list of the control "Size is", (see Figures 2-4), control 100 will be enable) (see col. 4, lines 9-27) (also see col. 5, lines 11-17).

The only difference between Livingston teaching and the claims is that in order to correct a condition for disabling control (change control 100 from disable to enable in Livingston), the claims teach selecting an adjustment button while Livingston teaches selecting on a list of items (for example, select "A4" in the drop-down list of control "Size is" (see Figure 4). Since Livingston teaches that "GUI components, such as icons or buttons, may visually represent figures for enabling computer functions" (col 1, lines 27-32), an Official Notice is taken that it would have been obvious for one of ordinary skill in the art, having the teaching of Livingston before him at the time the invention was made, to modify the graphical user interface taught by Livingston to include a button for selecting "A4" with the motivation being to provide different ways to select items.

Regarding claims 2, 10, and 14, Livingston teaches displaying an assistance icon for viewing by a user in responsive to said change state of said identified code to disabled with assistance state (help icon 110) (col. 4, lines 13) (see Fig. 3).

Regarding claims 3, 11, and 15, Livingston teaches identifying a user selection of said assistance icon and displaying said assistance text (col. 4, lines 18-23) (see Figures 2-3).

Regarding claim 6, Livingston teaches displaying a help text for viewing by a user (Fig. 3).

Regarding claims 7 and 18, Livingston teaches the step of providing an assistance icon with said identified code, said assistance icon for viewing by a user in a context menu of available actions for user selected items (help icon 110) (col. 4, lines 13) (see Fig. 3).

Regarding claims 5, 12, and 16, Livingston teaches receiving user selection to adjust a display control to execute said code for correcting a condition for disabling control (acting on eligible items) (upon user selection of A4 in the drop-down list of the control "Size is", (see Figures 2-4), control 100 will be enable) (see col. 4, lines 9-27) (also see col. 5, lines 11-17).

The only difference between Livingston teaching and the claims is that in order to correct a condition for disabling control (change control 100 from disable to enable in Livingston), the claims teach selecting an adjustment button while Livingston teaches selecting on a list of items (for example, select "A4" in the drop-down list of control "Size is" (see Figure 4). Since Livingston teaches that "GUI components, such as icons or buttons, may visually represent figures for enabling computer functions" (col 1, lines 27-32), an Official Notice is taken that it would have been obvious for one of ordinary skill in the art, having the teaching of Livingston before him at the time the invention was made, to modify the graphical user interface taught by Livingston to include a button for selecting "A4" with the motivation being to provide different ways to select items.

Regarding claim 13, Livingston teaches steps identifying code for disabling control (identify that control option 100 is disabled) (see col. 4, lines 10-14), changing a

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state of identified code from disabled to disabled with assistance (disabled option 100 is detected as being noteworthy) (col. 4, lines 9-11); responsive to said change of state of identified code to disabled with assistance, providing assistance text to explain why control is disabled (help information explaining why control 100 is disabled) (col. 4, lines 18-23) including identifying a restricted selection (context-specific message 115 identifies that the feature (i.e. control option 100) is restricted for use/selection) (see help text in Figure 3) and providing code for correcting a condition for disabling control including removing the restricted selection (providing guidance on what user should do to enable control 100) (col. 4, lines 18-23), receive user selection to adjust a display control to execute said code for correcting a condition for disabling control (upon user selection of A4 in the drop-down list of the control "Size is", (see Figures 2-4), control 100 will be enable) (see col. 4, lines 9-27) (also see col. 5, lines 11-17).

The only difference between Livingston teaching and the claims is that in order to correct a condition for disabling control (change control 100 from disable to enable in Livingston), the claims teach selecting an adjustment button while Livingston teaches selecting on a list of items (for example, select "A4" in the drop-down list of control "Size is" (see Figure 4). Since Livingston teaches that "GUI components, such as icons or buttons, may visually represent figures for enabling computer functions" (col 1, lines 27-32), an Official Notice is taken that it would have been obvious for one of ordinary skill in the art, having the teaching of Livingston before him at the time the invention was made, to modify the graphical user interface taught by Livingston to include a button for selecting "A4" with the motivation being to provide different ways to select items.

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9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston (USP 6,452,607) and Cohen-Levy et al ("Cohen-Levy", USP 5423034).

Regarding claim 17, Livingston teaches displaying help for viewing by a user (help information explaining why control 100 is disabled) (col. 4, lines 18-23) including identifying a restricted selection (context-specific message 115 identifies that the feature (i.e. control option 100) is restricted for use/selection) (see help text in Figure 3). Livingston does not teach displaying a privilege class for the restricted selection. However, such feature is known in the art as taught by Cohen-Levy. Cohen-Levy teaches a computer interface system comprising displaying user's network access privileges (see Fig. 5) (col. 18, lines 44-64). It would have been obvious for one of ordinary skill in the art, having the teaching of Livingston and Cohen-Levy before him at the time the invention was made, to modify the graphical user interface taught by Livingston to include displaying privilege class for selections to inform user which selection the user is allowed to choose.

10. Applicant's arguments filed 04/20/05 have been considered but they are not persuasive.

The Affidavit filed on 03/10/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Fang (USP 6628311) reference (see Section 2 above).

Applicant argues "The prior art fails.....which is claimed". This argument fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Therefore, the rejection of claims 1-3 and 5-12 based on Fang reference is maintained as cited in Section 7 above.

A new rejection of claims 1-3 and 5-12 based on Livingston reference is made of record as cited in Section 8 above.

New claims 13-16 and 18 are rejected based on teaching of Livingston as cited in Section 8 above.

New claim 17 is rejected based on teaching of Livingston and Cohen-Levy as cited in Section 9 above.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4057.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at 571-272-4048.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

703-872-9306

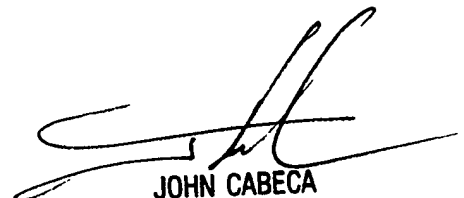
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kieu D. Vu
Patent Examiner



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